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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,964	07/03/2003	Mark Vaughn	100202889-1	6789
22879	7590	09/16/2009	EXAMINER	
HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528				OBEID, FAHD A
ART UNIT		PAPER NUMBER		
3627				
			NOTIFICATION DATE	DELIVERY MODE
			09/16/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/613,964	VAUGHN, MARK	
	<b>Examiner</b>	<b>Art Unit</b>	
	FAHD A. OBEID	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 July 2009.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

**DETAILED ACTION**

*Status of the Application*

1. **Claims 1-25** are pending in this application.

*Continued Examination Under 37 CFR 1.114*

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/08/2009 has been entered.

*Preliminary Remarks*

3. This is in reply to communication filed on 07/08/2009.
4. No claims have been added or cancelled.
5. Claims 1, 10, 19, and 22 have been amended.
6. Claims 1-25 are currently pending and have been examined.

*Specification Objections*

7. The amendment filed 07/08/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not

supported by the original disclosure is as follows: “providing the originator with a user interface to select specific images to be associated or disassociated with the predetermined economical ship quantities; automatically implementing a printing of the images included in the collection of images that are disassociated with the predetermined economical ship quantities and automatically delaying printing of images that are associated with the predetermined economical ship quantities until a total number of the images included in the collection of images breaches the print quantity”.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Objections***

8. Claims 1, 10, 19, and 22 are objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the claims recite “automatically delaying printing of images that are...” should be “automatically delaying printing of the/said images that are...”

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1, 10, 19 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. The applicant's amendment filed on 07/08/2009 contains the limitation "providing the originator with a user interface to select specific images to be associated or disassociated with the predetermined economical ship quantities; automatically implementing a printing of the images included in the collection of images that are disassociated with the predetermined economical ship quantities and automatically delaying printing of images that are associated with the predetermined economical ship quantities until a total number of the images included in the collection of images breaches the print quantity" is considered new matter since it does not have any support in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1, 10, 19, and 22 recite the limitation "the print quantity being associated with predetermined economical ship quantities of the recipient". There is insufficient antecedent basis for this limitation in the claim.

13. Claims 19-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim elements "means for" are means plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. There is insufficient disclosure of the corresponding structure, material, or acts for performing the claimed function.

Applicant is required to:

- (a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- (b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or
- (b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

14. Claims 1-9 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, a 35 U.S.C § 101 process must (1) be tied to a particular machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps are not tied to a particular machine and do not perform a transformation. Thus, the claims are non-statutory.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. *Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.*

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**16. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reifel (US 7,013,288) in view of Kurz (US 6,584,290) and further in view of Barns-Slavin (US 5,995,950).**

17. Regarding Claims 1, 10, 19, and 22: Reifel discloses a method for print fulfillment, comprising the steps of:

- maintaining a print quantity in a server, the print quantity being associated with predetermined economical ship quantities of a recipient (fig 8–9, col 2 lines 5-10 and col 6 lines 20-42);
- accumulating a collection of images received from an originator in the server, the collection of images being associated with the recipient (figs 8-9);
- providing the originator with a user interface to select specific images to be associated or disassociated with the predetermined economical ship quantities (++++);
- automatically implementing a printing of the images included in the collection of images that are disassociated with the predetermined economical ship quantities and automatically delaying printing of the images that are associated with the predetermined economical ship quantities until a total number of the images included in the collection of images breaches the print quantity (figs 2-4, col 4 lines 20-30, col 13 lines 33-36, col 16 lines 19-37 and claim 11).

Reifel does not explicitly teach determining a print quantity defined by a predetermined economical ship quantity and automatically printing the images when a total number of the images breaches the print quantity.

However, Kurz does teach automatically printing the documents (images) after an indication of a threshold condition (col 7 lines 16-18 and claim 7).

While Barns-Slavin teach determining a print quantity defined by a predetermined economical ship quantity (discounted shipping charges can be determined for number of parcels to be shipped to a consignee; col 1 lns 12-43).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Kurz's and Barns-Slavin teachings in Reifel's "method and system for managing the distribution of images and prints" enabled, for the advantage of ordering a large quantity of prints to be shipped at a reduce price.

18. Regarding Claims 2, 11, 20, and 23: Reifel disclose a method of claim 1, wherein the step of implementing the printing of the image included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises the steps of: printing each of the images in the collection of images; and shipping the images to the recipient (figs 8-9, col 13 lines 35-37, col 17 lines 12-16, and col 18 lines 36-48).

19. Regarding Claims 3, 12, 21, and 24: Reifel disclose a method of claim 1, wherein the step of implementing the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity further comprises the steps of:

- Transmitting each of the images in the collection of images to a print vendor for printing (col 5 lines 28-30, col 12 lines 17-27, and col 15 lines 55-60)
- Transmitting a ship address associated with the recipient to the print vendor to facilitate shipping of printed ones of the image to the recipient (figs 4, 5, 7A, col 18 lines 26-29, and col 18 lines 36-48).

20. Regarding Claims 4, 13 and 25: Reifel disclose a method of claim 3, further comprising the step of tracking a total number of the images transmitted to the print vendor for printing (col 9 lines 32-38, col 12 lines 49-62, and col 16 lines 34-37).

21. Regarding Claims 5 and 14: Reifel disclose a method of claim 1, further comprising the step of implementing the printing of the images included in the collection of images upon receipt of an order for immediate printing of the collection of images from the originator (figs 3-5, col 5 lines 45-61, and col 6 lines 37-42).

22. Regarding Claims 6 and 15: Reifel disclose a method of claim 1, wherein the step of accumulating the collection of images received from the originator in the server further comprises the steps of:

- Receiving a number of images from the originator (figs 5 and 8).
- Adding each of the number of images to the collection of images (figs 5 & 8, and col 6 lines 37-42).

- Determining if the total number of the images included in the collection of images breaches the print quantity after adding each of the number of images to the collection of images (col 16 lines 29-37).

23. Regarding Claims 7 and 16: Reifel disclose a method of claim 1, further comprising the step of acknowledging a receipt of a number of images to the originator (col 19 lines 42-51).

24. Regarding Claims 8 and 17: Reifel disclose a method of claim 1, further comprising the step of sending a print notification to the originator when the total number of the images included in the collection of images breaches the print quantity (col 19 lines 42-51).

25. Regarding Claims 9 and 18: Reifel disclose a method of claim 1, further comprising the step of obtaining a payment for the implementation of the printing of the images included in the collection of images when the total number of the images included in the collection of images breaches the print quantity (fig 8-9, col 5 lines 35-44, col 11 lines 4-6, col 20 lines 50-57).

#### ***Response to Arguments***

26. Applicant's arguments have been fully considered but they are not persuasive. In particular the applicant argues that: a) the combination of Reifel, Kurz, and Barns\_Slavin do not teach maintaining a print quantity associated with predetermined economical ship quantities of the recipient.

In response to a) examiner respectfully disagrees. Applicant is reminded that claims must be given their broadest reasonable interpretation. Reifel teaches a consumer can

optionally modify the presented information as needed or desired, the consumer can specify that only certain images are to be reproduced and can specify the type and size of image reproductions on an image-by-image basis (col 18 lns 42-46).

Therefore, the combination of Reifel, Kurz, and Barns Slavin still meet the scope of the limitation as currently claimed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/

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Examiner, Art Unit 3627  
September 10, 2009

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627